



DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Agency Information Collection Activities; Submission to the Office of Management and Budget (OMB) for Review and Approval; Comment Request; Third-Party Submissions and Protests

ACTION: Notice of information collection; request for comment.

SUMMARY: The United States Patent and Trademark Office (USPTO), in accordance with the Paperwork Reduction Act of 1995, invites comments on the extension and revision of an existing information collection: 0651-0062 (Third-Party Submissions and Protests). The purpose of this notice is to allow 60 days for public comment preceding submission of the information collection to OMB.

DATES: To ensure consideration, comments regarding this information collection must be received on or before [INSERT DATE 60 DAYS AFTER THE DATE OF PUBLICATION IN THE FEDERAL REGISTER].

ADDRESSES: Interested persons are invited to submit written comments by any of the following methods. Do not submit Confidential Business Information or otherwise sensitive or protected information.

- *Email:* InformationCollection@uspto.gov. Include “0651-0062 comment” in the subject line of the message.
- *Federal Rulemaking Portal:* <http://www.regulations.gov>.
- *Mail:* Kimberly Hardy, Office of the Chief Administrative Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313–1450.

FOR FURTHER INFORMATION CONTACT: Requests for additional information should be directed to Parikha Mehta, Patent Examination Policy Advisor, Office of Patent Legal Administration, United States Patent and Trademark Office, P.O. Box 1450, Alexandria,

VA 22313-1450; by telephone at 571-272-3248; or by e-mail to Parikha.Mehta@uspto.gov with “0651-0062 comment” in the subject line. Additional information about this information collection is also available at <http://www.reginfo.gov> under “Information Collection Review.”

SUPPLEMENTARY INFORMATION:

I. Abstract

The United States Patent and Trademark Office (USPTO) is required by 35 U.S.C. § 131 *et seq.* to examine an application for patent and, when appropriate, issue a patent. The provisions of 35 U.S.C. §§ 122(c), 122(e), 131, and 151, as well as 37 CFR 1.290 and 1.291, limit the ability of a third-party to have information entered and considered in, or to protest, a patent application pending before the USPTO.

37 CFR 1.290 provides a mechanism for third parties to submit to the USPTO, for consideration and inclusion in the record of a patent application, any patents, published patent applications, or other printed publications of potential relevance to the examination of the application.

A third-party submission under 37 CFR 1.290 may be made in any nonprovisional utility, design, and plant application, as well as in any continuing application. A third-party submission under 37 CFR 1.290 must include a concise description of the asserted relevance of each document submitted, and must be submitted within a certain statutorily specified time period.

37 CFR 1.291 permits a member of the public to file a protest against a pending application. Protests pursuant to 37 CFR 1.291 are supported by a separated statutory provision from third-party submissions under 37 CFR 1.290. As a result, there are several differences between protests and third-party submissions, as explained in the table below.

Table 1: Comparison of Third-Party Submission and Protests

Comparison	Third-Party Submission	Protest
Statute/ Regulation	35 U.S.C. § 122(e) 37 CFR 1.290	35 U.S.C. § 122(c) 37 CFR 1.291
Content	Printed publications	Printing publications and any facts or information adverse to patentability
Remarks	Concise description of relevance (limited to a concise description of each document's relevance)	Concise explanation of the relevance (allows for arguments against patentability)
Timing	Prior to Allowance and prior to later of: 6 months after Pre-Grant Publication or first rejection of any claim	Prior to Allowance and prior to Pre-Grant Publication OR Prior to Allowance and after and after Pre-Grant Publication with application consent

This information collection covers the items needed to provide the public the means to submit information and protests regarding patent applications to the USPTO. This information collection is necessary so that the public may contribute to the quality of issued patents. The USPTO will use this information, as appropriate, to assist in evaluating the patent application as it moves through the patent examination process.

II. Method of Collection

OMB Control Number: 0651-0062.

Form Number:

- PTO/SB/429 (Third-Party Submission Under 37 CFR 1.290)

Type of Review: Extension and revision of a currently approved information collection.

Affected Public: Private sector; individuals or households.

Estimated Number of Respondents: 880 per year.

Estimated Number of Responses: 880 per year.

Estimated Time per Response: The USPTO estimates that it takes the public approximately 10 hours to complete this information, depending upon the application. This includes the time to gather the necessary information, prepare and maintain the documents, and submit the items to the USPTO.

Estimated Total Annual Hour Burden: 8,800 hours.

Estimated Total Annual Cost Burden (Hourly): \$3,520,000.

Table 2: Burden Hour/Burden Cost to Respondents for Private Sector

Item No.	Item	Estimated Annual Respondents	Estimated Annual Responses (year)	Estimated Time for Response (hours)	Estimated Annual Burden (hour/year)	Rate ¹ (\$/hour)	Estimated Annual Respondent Cost Burden
			(a)	(b)	(a) x (b) = (c)	(d)	(c) x (d) = (e)
1	Third-Party Submissions in Nonissued Applications	800	800	10	8,000	\$400	\$3,200,000
2	Protests by the Public Against Pending Applications Under 37 CFR 1.291	19	19	10	190	\$400	\$76,000
	Total	819	819		8,190		\$3,276,000

Table 3: Burden Hour/Burden Cost to Respondents for Individuals or Households

Item No.	Item	Estimated Annual Respondents	Estimated Annual Responses (year)	Estimated Time for Response (hours)	Estimated Annual Burden (hour/year)	Rate ² (\$/hour)	Estimated Annual Respondent Cost Burden
			(a)	(b)	(a) x (b) = (c)	(d)	(c) x (d) = (e)
1	Third-Party Submissions in Nonissued Applications	60	60	10	600	\$400	\$240,000
2	Protests by the Public Against Pending Applications Under 37 CFR 1.291	1	1	10	10	\$400	\$4,000
	Total	61	61		610		\$244,000

Estimated Total Annual (Non-hour) Respondent Cost Burden: \$80,456. This information collection has no capital start-up, maintenance, or operating fees. However, there are postage costs and filing fees. The total non-hour respondent cost burden for this information collection in the form of filing fees (\$80,335) and postage costs (\$121) is approximately \$80,456.

¹ 2019 Report of the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA); <https://www.aipla.org/detail/journal-issue/2019-report-of-the-economic-survey>. The USPTO uses the mean rate for attorneys in private firms which is \$400 per hour.

² 2019 Report of the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA); <https://www.aipla.org/detail/journal-issue/2019-report-of-the-economic-survey>. The USPTO uses the mean rate for attorneys in private firms which is \$400 per hour.

In particular, 37 CFR 1.290 requires payment of the fee set forth in 37 CFR 1.17(o) for every ten documents, or fraction thereof, listed in each third-party submission.

The USPTO provides an exemption from the 1.17(o) fee requirement where a third-party submission listing three or fewer total documents is the first third-party submission submitted in an application by the third-party, or a party in privity with the third-party. The effect of this is that the first three documents submitted by a third-party are exempt from the fee requirement. However, the submission of four or more documents by a third-party triggers the collection of the fee.

There is no fee for filing protests under 37 CFR 1.291 unless the filed protest is the second or subsequent protest by the same real party in interest, in which case the 37 CFR 1.17(i) fee must be included. The USPTO estimates that only 1 out of every 10 protests filed per year will require this fee.

Table 4: Filing Fees

Item No.	Item	Estimated Annual Responses (a)	Filing fee (\$) (b)	Total Non-hour Cost Burden (\$) (a) x (b) = (c)
1	Third-Party Submissions in Nonissued Applications (undiscounted entities)	390	\$180	\$70,200
1	Third-Party Submissions in Nonissued Applications (small and micro entities)	110	\$90	\$9,900
2	Protests by the Public Against Pending Applications Under 37 CFR 1.291– second or subsequent protest by the same real party in interest (undiscounted entities)	1	\$130	\$130
2	Protests by the Public Against Pending Applications Under 37 CFR 1.291 – second or subsequent protest by the same real party in interest (small entities)	1	\$70	\$70
2	Protests by the Public Against Pending Applications Under 37 CFR 1.291 – second or subsequent protest by the same real party in interest (micro entities)	1	\$35	\$35
	Total	--	--	\$80,335

Although the USPTO prefers that the items in this information collection be submitted electronically, responses may be submitted by mail through the United States Postal Service (USPS). The USPTO estimates that the average postage cost for a mailed

submission, using a Priority Mail 2-day flat rate legal envelope, will be \$8.05. The USPTO estimates that 15 submissions may be mailed to the USPTO, for a total postage cost of \$121 per year.

Respondent's Obligation: Required to obtain or retain benefits.

IV. Request for Comments

The USPTO is soliciting public comments to:

- (a) Evaluate whether the proposed collection of information is necessary for the proper performance of the functions of the Agency, including whether the information will have practical utility;
- (b) Evaluate the accuracy of the Agency's estimate of the burden of the proposed collection of information, including the validity of the methodology and assumptions used;
- (c) Enhance the quality, utility, and clarity of the information to be collected; and
- (d) Minimize the burden of the collection of information on those who are to respond, including through the use of appropriate automated, electronic, mechanical, or other technological collection techniques or other forms of information technology, e.g., permitting electronic submission of responses.

All comments submitted in response to this notice are a matter of public record. USPTO will include or summarize each comment in the request to OMB to approve this information collection. Before including an address, phone number, email address, or other personal identifying information (PII) in a comment, be aware that the entire comment—including PII—may be made publicly available at any time. While you may ask in your comment to withhold PII from public view, USPTO cannot guarantee that it will be able to do so.

Kimberly Hardy,
Information Collections Officer,
Office of the Chief Administrative Officer,
United States Patent and Trademark Office.

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